

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: **Robert Paul Black**      Confirmation No.: **6283**  
Serial No.: **09/308,515**      Group Art Unit: **1771**  
Filing Date: **August 11, 1999**      Examiner: **Andrew T. Piziali**  
For: **Filling Comprising A Polyester Fibre**

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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**APPELLANT'S REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41**

Appellants submit this Reply in response to the Examiner's Answer dated April 23, 2007 in connection with the above-identified application. This reply is being filed within two months of said answer.

**1. STATUS OF CLAIMS**

Claim 1	Rejected and On Appeal
Claim 2	Rejected and On Appeal
Claim 3	Canceled
Claim 4	Rejected and On Appeal
Claim 5	Rejected and On Appeal
Claim 6	Rejected and On Appeal
Claim 7	Rejected and On Appeal
Claim 8	Rejected and On Appeal
Claim 9	Rejected and On Appeal
Claim 10	Rejected and On Appeal
Claim 11	Rejected and On Appeal
Claim 12	Rejected and On Appeal
Claims 13-17	Canceled

**2. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

Whether Claims 4-7 and 10 are properly rejected under 35 USC §112, second paragraph, as lacking antecedent basis for reciting "the cellulosic fibre."

Whether Claims 1, 4-8, and 10 are properly rejected under 35 USC §103 as obvious over GB 1,370,296 ("the Pedler reference") in view of US Patent No. 5,725,821 ("the Gannon reference").

Whether Claims 2 and 9 are properly rejected under 35 USC §103 as obvious over the Pedler reference in view of the Gannon reference, further in view of US Patent No. 5,023,131 ("the Kwok reference").

Whether Claim 11 is properly rejected under 35 USC §103 as obvious over US Patent No. 4,992,327 ("the Donovan reference") in view of the Gannon reference.

Whether Claim 12 is properly rejected under 35 USC §103 as obvious over the Kwok reference in view of the Gannon reference.

### 3. ARGUMENT

#### A. Rejection under 35 USC §112, second paragraph

This rejection does not apply to claims 1-2, 8-9, and 11-12. It is believed that the Examiner is taking an unreasonable stance with regard to the wording of claims 4 through 7 and 10. Every person skilled in the art understands that lyocell is a cellulosic fiber. Consequently, the reference in claims 4 through 7 and 10 to "the cellulosic fiber" can only refer to the lyocell mentioned in claim 1 since there is no other cellulosic fiber referred to in the claims. (emphasis added).

It is believed that the approach taken by the Examiner in this regard is unrealistic and improper and ignores any consideration that a person skilled in the art would apply to the wording in question. In particular, it is believed that the existing wording is both clear and unambiguous and that the claims therefore satisfy the requirements of 35 USC § 112 of "particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention".

It is also noted that claims 4 through 7 and 10 do not refer to "cellulosic fiber" but refer specifically to "the cellulosic fiber" (emphasis added). In view of the fact that each of claims 4 through 7 and 10 is dependent directly upon claim 1, the reference to "the cellulosic fiber" can only refer to the cellulosic fiber referred to in claim 1, namely lyocell. (emphasis added). Reference to merely "cellulosic fiber" would include fiber other than lyocell, but this is not the case in the claims as they stand.

#### B. Rejections under 35 U.S.C. § 103.

With regard to the Examiner's Answer in connection with the objections under 35 USC § 103, it is noted that the Examiner relies on GB 1 370 296 ("Pedler") in combination with U.S. Patent No. 5,725,821 ("Gannon"). The Examiner has discussed features of Pedler and Gannon which, according to the Examiner, can be combined to arrive at the present invention. However, the Examiner has failed to address a much more fundamental issue; a person skilled in the art would not seek to combine Pedler and Gannon.

For example, Pedler relates to a non-woven fibrous material pad and a method of making such a pad by adhering together two felt layers with a layer of coloured adhesive. (Pedler at pg. 2 lines 9-24). In contrast, Gannon relates to a specific method of manufacturing lyocell fiber. (Gannon at col. 1, lines 5-6). In other words, Gannon relates to a method for producing staple fibers which are then distributed to third parties. However, a

person skilled in the art of non-woven fibrous materials such as those described in Pedler would have no interest whatsoever in the details of how the constituent fibers are manufactured, merely that the fibers are of the right type and that they possess the desired qualities such as fiber length, fiber thickness, etc.

Gannon discusses details such as the dissolving of cellulose in a tertiary amine N-oxide solvent to form a solution, extruding the solution through a die to form a plurality of filaments, washing the filaments to remove the solvent, and drying the fiber. (Gannon at col. 2, lines 2-13). A person skilled in the art of the end uses of lyocell would have no interest whatsoever in such detail, and therefore, would not look to Gannon at all. Therefore, the combination of Pedler and Gannon is not one which such a person would make except in hindsight.

In view of the above, it is probably not surprising that the technical classifications of Pedler and Gannon are very different from one another. The International Classification of Pedler is B32B whereas the International Classifications of Gannon are D01D and D01F. Thus, the technical classifications of Pedler are not even adjacent to one another - they are poles apart. Therefore, a person skilled in the art when considering the subject matter of Pedler, could not be expected to find Gannon and as a consequence could not be expected to consider the disclosure of Gannon.

It should also be borne in mind that the test is not whether a person could have combined two documents to achieve the claimed invention (which, as indicated above, we dispute in any case) but whether a person would have done so. See MPEP 2144 citing *Ex parte Levengood*, 28 USPQ2d 1300, 1302 (Bd. Pat. App. & Inter. 1993)(stating that obviousness cannot be established by combing references "without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done."). In this regard, there is no suggestion in Gannon that its disclosure could be - or should be - combined with the Pedler disclosure. On the contrary, none of the prior art documents cited by the United States Patent and Trade Mark Office in the Examination of Gannon discloses a single document having even a remotely similar technical classification to Pedler. Indeed, the prior art citations in Gannon relate to methods for forming cellulosic material which, as indicated above, is not in the least surprising.

It is perhaps worth noting that, prior to the most recent Office Action which forms the subject of this Appeal, no fewer than 13 prior art references were relied on in the various Office Actions in objections of lack of novelty or obviousness. These are summarized briefly below:

<u>Office Action</u>	<u>References</u>
12/07/2000	US 5,928,973 GB 2 324 064
08/29/2001	JP 08-172224 GB 2 324 064 GB 1 486 639
04/11/2002	US 5,532,050 JP 08-170224 GB 1 486 639
11/06/2002	US 5,344,707 US 4,719,144
04/25/2003	US 5,344,707 US 3,616,150 US 5,066,527
12/03/2003	US 3,616,150 US 5,344,707
06/17/2004	US 5,344,707 US 3,616,150
01/27/2005	GB 1 370 296 US 4,992,327 US 5,023,131 US 5,725,821

Therefore, the Examiner has made no fewer than **EIGHT** previous attempts to use prior art documents and combinations of prior art documents to find the present invention unpatentable. In each case, until the most recent step, the objection has been overcome. The Examiner, however, has now found a combination of documents with which he feels comfortable - at the ninth attempt - in showing that the present invention is obvious.

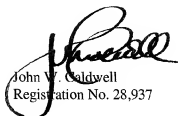
The use of thirteen different prior art documents in eight previous attempts to demonstrate unpatentability must be an indication of the strongest type possible that a combination of Pedler and Gannon would only be made following an *ex post facto* approach. To put it another way, the Examiner is asking us to believe that a person would (not could but would) have sought to combine Pedler and Gannon without any inventive thought at the date of creation of the present invention. However, it has taken the Examiner himself **EIGHT** attempts to construct a combination of features which it has not been possible to persuade him to waive. Even then, the Examiner has trawled far and wide and has resorted to a document relating to the manufacture of the basic staple lyocell fiber with which a person skilled in the art of the subject matter of Pedler would have no motivation to combine his knowledge with.

The above does not even discuss the fact, in our submission, that even a hypothetical combination of Pedler or Gannon would not result in the present invention. Those arguments are contained in the Appeal Brief. The important point being made at the present time is that a person skilled in the art would not have got to the stage of seeking to combine Pedler and Gannon.

With regard to the objections against the subsidiary claims, all of those claims are dependent upon claim 1. Therefore, in view of the submissions that the subject matter of

claim 1 is patentable, it is not believed that any arguments in support of the subsidiary claims is necessary, helpful or desirable.

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